

REMARKS/ARUGMENTS

Upon entry of this amendment, claims 1 and 5 will be amended, claims 2-4, 6 and 7 will be canceled, and claim 8 will be added, whereby claims 1, 5 and 8 will remain pending. Claims 1 and 8 are independent claims.

The Examiner's attention is directed to Applicant's originally filed specification with respect to support for newly-added method claim 8. For example, attention is directed to page 8, the first full paragraph.

Reconsideration and allowance of the application are respectfully requested.

Consideration Of Disclosure Statement

Applicant expresses appreciation for the inclusion with the Office Action of a copy of the initialed Forms PTO-1449, whereby the Examiner's consideration of the Information Disclosure Statement, filed April 23, 2003, is of record.

Moreover, Applicant is submitting herewith a Supplemental Information Disclosure Statement to submit a copy of a document cited in the specification so that the Examiner can formally confirm consideration thereof. The Examiner is respectfully requested to initial the Form PTO-1449 submitted with the Supplemental Information Disclosure Statement, and to forward an initialed copy of the form with the next communication from the Patent and Trademark Office.

Claim Of Priority

Applicant expresses appreciation for the acknowledgment in the Office Action of the claim of foreign priority as well as receipt of the certified copies of the priority documents, i.e., Japanese Application Nos. 11/14261 and 11/280257, in the instant national stage application.

Response To Rejections Based Upon Prior Art

The following rejections are set forth in the Office Action:

- (a) Endo Y. et al. (hereinafter "Endo I"), "Estrogenic antagonists bearing dicarba-closo-dodecaborane as a hydrophobic pharmacophore", Bioorg. Med. Chem. Lett., Vol. 9, No. 24, pp. 3387-3392 (1999) - Structure 1 on page 3388.
- (b) Endo Y. et al. (hereinafter "Endo II"), "Potent estrogenic agonists bearing dicarba-closo-dodecaborane as a hydrophobic Pharmacophore", J. Med. Chem., Vol. 42, No. 9, pp. 1501-1504 (1999) - Structure 2a, 2b and 2c.
- (c) Brown D.A. et al., "Polymers and ceramics based on icosahedral carboranes, model studies of the formation and hydrolytic stability of aryl ether, ketone, amide, and borane linkages between carborane units", J. Mater. Chem., Vol. 2, No. 8, pp. 793-804 (1992) - Page 796, Structure 17.

In response to the rejections of record, Applicant respectfully submits the following.

Regarding the rejections based upon the Endo documents, we note that these rejections are not properly made under 35 U.S.C. 102(b). In particular, the documents were published less than one year before the International Filing Date of January 21, 2000 of PCT/JP00/00285 of which the

present application is the U.S. national stage. In accordance with 35 U.S.C. 363, the filing date of this national stage application is the PCT filing date.

Still further, the present application claims priority of JP 11/14261, filed January 22, 1999, and JP 11/280257, filed September 30, 1999.

Regarding the publication dates of Endo I and Endo II, it is noted that Endo I indicates (on the first page thereof) that it was received September 3, 1999 and accepted October 16, 1999. Therefore, it would appear that the earliest publication date of Endo I is subsequent to October 16, 1999. With respect to the publication date of Endo II, Applicant notes that Endo II indicates (on the first page thereof) that it was received February 11, 1999. Moreover, Applicant is submitting herewith a copy of a first page of a printout on December 21, 2003 of the American Chemical Society publications web site indicating a date of May 6, 1999 for the journal containing Endo II. Accordingly, it appears that Endo II published around May 6, 1999.

Still further, Applicant is submitting herewith verified English translations of the two Japanese priority applications. The Examiner is respectfully requested to review these verified translations and to withdraw the rejection of record, because the dates of Endo I and Endo II should be considered to have been overcome. In particular, the Examiner is requested, in conformance with MPEP 201.15, to review the submitted verified English translations to determine identity of invention between the U.S. and the foreign applications, to review for sufficiency of disclosure under 35 U.S.C. 112, and to determine if there is a basis for the claims sought.

Applicant respectfully requests that the rejections based upon Endo I and Endo II be withdrawn upon review of the submitted information.

Moreover, with respect to the rejection based upon Brown, Applicant notes that claims 1 and 5 have been amended herein to substantially include the subject matter recited in claims 2 and 6. In this regard, as noted in the International Preliminary Examination Report, the inventions of 2 and 6 are considered to be novel and involve an inventive step. Therefore, if the rejection of the amended claims is maintained, the anticipation rejection is specifically requested to indicate how each and every element recited in Applicant's claims is considered to be included in the prior art.

In view of the above, the rejections of record should be withdrawn.

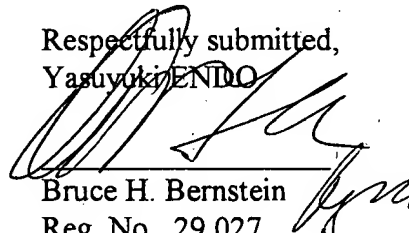
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Applicant therefore respectfully requests that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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